

Docket No. 200308565-1

Remarks

This paper is responsive to the Office Action of April 21, 2006. Reexamination and reconsideration of claims 1-44 is respectfully requested.

Summary of The Office Action

Claims 1, 3, 5-16, and 29-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Long et al. (US Pat. No. 6,393,545)(Long) and **Shidla et al.** (US PG Pub. No. 20050050276)(Shidla et al.). **Shidla et al.** names three inventors, Dale J. Shidla, Andrew H. Barr, and Ken G. Pomaranski, the exact same three inventors as listed in the application. Thus, Shidla et al. does not qualify as prior art and these rejections should be withdrawn.

Claims 17-19, 21-25, 28, 35-38 and 41-43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Long, **Shidla et al.**, and Leung et al. (US PG Pub. No. 20050044467)(Leung). **Shidla et al.** names three inventors, Dale J. Shidla, Andrew H. Barr, and Ken G. Pomaranski, the exact same three inventors as listed in the application. Thus, Shidla et al. does not qualify as prior art and these rejections should be withdrawn.

Claims 26 - 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Long, **Shidla et al.**, Leung, and Nakamura (US Pat. No. 6,523,135)(Nakamura). **Shidla et al.** names three inventors, Dale J. Shidla, Andrew H. Barr, and Ken G. Pomaranski, the exact same three inventors as listed in the application. Thus, Shidla et al. does not qualify as prior art and these rejections should be withdrawn.

Claims 2, 40 and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Long, **Shidla et al.**, and Idleman et al. (US Pat. No. 5,274,625)(Idleman). **Shidla et al.** names three inventors, Dale J. Shidla, Andrew H. Barr, and Ken G. Pomaranski, the exact same three inventors as listed in the application. Thus, Shidla et al. does not qualify as prior art and these rejections should be withdrawn.

Claims 4, 20, and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Long, **Shidla et al.**, and Chauvel et al. (US PG Pub. No. 20040024970)(Chauvel). **Shidla et al.**

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names three inventors, Dale J. Shidla, Andrew H. Barr, and Ken G. Pomaranski, the exact same three inventors as listed in the application. Thus, Shidla et al. does not qualify as prior art and these rejections should be withdrawn.

Shidla et al. Does Not Qualify as Prior Art

All the claims were rejected under 35 U.S.C. §103(a) over a combination of references, each of which included Shidla et al. 35 U.S.C. §103(a) prior art is limited to those items within 35 U.S.C. §102. Since Shidla et al. names the exact same three inventors as the application, Shidla et al. is not within 35 U.S.C. §102 and thus cannot be used as a 35 U.S.C. §103 reference. Concerning this issue, the Federal Circuit has stated that an inventor's own work cannot be prior art against the inventor absent a statutory basis. *Riverwood Intl. Corp. v. R.A. Jones & Co.*, 66 USPQ 2d 1331 (Fed. Cir. 2003). Examining the possible statutory bases leads to the conclusion that the reference listing the same inventors as the application cannot be prior art against the inventors.

35 U.S.C. §102(a) reads:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Here, the invention was not known or used by others. To the extent that the reference shows that any part of the invention was known before the application date, the reference does not show that it was known by others.

35 U.S.C. §102(b) reads:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

Here, the invention was not patented or described more than one year prior to the date of the application.

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35 U.S.C. §102(c) reads:

A person shall be entitled to a patent unless –

(c) he has **abandoned** the invention.

Here, the applicant has not abandoned his invention.

35 U.S.C. §102(d) reads:

A person shall be entitled to a patent unless –

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns **in a foreign country prior to the date of the application for patent** in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

Here, the invention was not patented in a foreign country prior to the date of the application for patent.

35 U.S.C. §102(e) reads:

A person shall be entitled to a patent unless –

(e) the invention was described in – (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Here there was no such description or publication.

35 U.S.C. §102(f) reads:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Here the inventor invented the subject matter.

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35 U.S.C. §102(g) reads:

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Here, there is no interference and no priority claim.

This exhausts all possible 35 U.S.C. §102 statutory bases by which the reference could be made prior art. It is indisputable that the reference is the inventor's own work as evidenced by the identical list of inventors (Shidla, Barr, Pomaranski). Any possible statutory basis would fail since the reference and the application were filed on 8/29/03 and 9/16/03 respectively. It is axiomatic that Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Since Shidla et al. does not qualify as prior art, and since all the rejections depend on Shidla et al., Applicant respectfully requests that these rejections be removed and that the application be allowed to issue.

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Hindsight Reconstruction

Applicant will now comment on the propriety of combining three and four references in the manner performed in the Office Action. This appears to be hindsight reconstruction where the Office Action is using the Application as a blueprint to find parts of the claimed invention in unrelated references. Hindsight reconstruction has long been frowned upon:

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without **hindsight reconstruction** of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or **hindsight reconstruction** to supply deficiencies in its factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968) (emphases in original).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP 2143.01

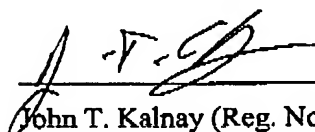
Here, the type of hindsight reconstruction engaged in by the Office Action is clearly impermissible.

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Conclusion

For the reasons set forth above, an early allowance of all claims is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. T. Kalnay", is written over a horizontal line.

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